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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/187,907 11/06/98 GIRARDI V E-775

WM01/0321

STEVEN J SHAPIRO
PITNEY BOWES INC INTELLECTUAL PROP AND
TECHNOLOGY LAW DEPT 35 WATERVIEW DR
P O BOX 3000
SHELTON CT 06484

EXAMINER

HEWITT II, C

ART UNIT	PAPER NUMBER
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2161

DATE MAILED:

03/21/01

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

WTH

Office Action Summary

Application No.

09/187,907

Applicant(s)

GIRARDI ET AL.

Examiner

Calvin L Hewitt II

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Status of Claims

1. Claims 1-9 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara, U.S. 5,801,944 in view of Bresnan et al., U.S. Patent No. 5,873,073 and File, U.S. Patent No. 5,174,493.

As per claims 1-9, Kara teaches a method and processor based system for printing indicia onto a document (abstract, lines 1-14; figures 16A, B and 18; column 6, 10-34). Kara also teaches document folding (column/line 5/65-6/4). However, Kara does not teach of fold configuration selection. File teaches C and Z fold reply envelopes (figures 1-9). Although, File does not disclose half-folds, the Examiner takes Official Notice that document fold configurations are well known in the art of document and mail processing.

And, that these folds can be applied according to the message that a user would like to convey to the document or mailer recipient. Bresnan et al. teach a mail piece production system. In particular, Bresnan et al. discloses a method and system for producing a finished mail piece that:

- allows users to select first and second fold configurations (column 8, lines 40-62; column/line 9/63-10/8)
- allows users to select amongst half, C or Z folds (column 8, lines 56-62; column 10, lines 5-7)
- identifies to the processor the configuration selections and creating the document the document (column 2, lines 21-50; column 3, lines 15-56; column 8, lines 40-62; column/line 9/63-10/8)
- allows a user to input secondary information such as paper size (column 8, lines 60-62)
- document printing, metering, return envelopes and inserts (abstract, lines 4-17; column/line 9/63-10/26; column 11, lines 20-38; column/line 18/61-19/12).

Therefore, it would have been obvious to combine the teachings of Kara, File and Bresnan et al. Mailers that include reply documents as part of a document or as inserts are well known. Some of these reply mailings have postage already accounted for by the mailer source (e.g. "No postage necessary..."). Using the system of Kara a user can print a first postage indicia on the original document and a second indicia on the reply

document. File teaches that a “reply” can have a plurality of fold configurations (‘493, column 1, lines 40-43). By applying the configuration selection of Bresnan et al., a user can accommodate multiple configurations and print indicia accordingly (‘944, figures 16A and B; ‘073, abstract, lines 8-13).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure:

- Taylor teaches a mailer with return envelope
- Sauerwine et al. teach a single sheet Z-fold mailer
- Harvey et al. teach encrypted postage indicia printing for mailer inserting systems
- Harman et al. teach a document control page interface.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label

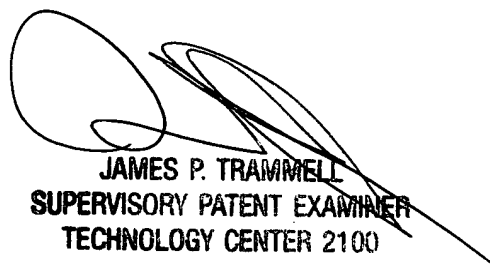
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should
be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

March 14, 2001


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100